

## REMARKS

Claims 1-46 were pending in the present application. In this response, no claims have been withdrawn from consideration, cancelled or amended. Accordingly, claims 1-46 are currently under consideration.

### Rejections under 35 U.S.C. § 103(a)

The office has rejected claims 1-46 as allegedly being unpatentable over Marshall (US 5,675,746) in view of Hatori et al. Applicant respectfully traverses the rejection. While the Examiner has slightly changed the stated motivation for combining the cited references, the Examiner essentially still improperly alleges a “design choice” motivation. Before turning to our detailed refutation of the rejection, we note that the Examiner’s restatement of the claim language appears to be incorrect -- claim 1 does not recite *linear* portions.

The Examiner contends that “an artisan at the time of the invention would have considered various methods to spatially represent and communicate the various financial information . . .” However, the Examiner is just restating the improperly-alleged “design choice” language of the obviousness rejection in the previous office action. The Examiner appears to be shifting the burden to the Applicant to demonstrate unexpected results.

Applicant recognizes that, in some instances, such a burden shift is proper. This is not one of those instances. In general, an Applicant can *rebut* a properly-made prima facie case of obviousness by presenting evidence of unexpected results. See, e.g., *In re Spada*, 911 F.2d 705, 708 n.3, 15 USPQ2d 1655 n.3 (Fed. Cir. 1990) (“The prima facie case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it.”) In the present instance, however, the Examiner has not properly made a prima facie case of

obviousness. Therefore, the requirement to present evidence of unexpected results is likewise improper.

We now explore in greater detail why the Examiner has failed to properly make a prima facie case of obviousness. Put simply, the Examiner has not presented any evidence to support the statement that an artisan "would have considered various methods to spatially represent and communicate the various financial information." Applicant recognizes that, in general, much is known to one of ordinary skill in the art. However, what is known is only the first part of the inquiry. The next part of the inquiry is whether one of ordinary skill in the art would be motivated *to combine* this knowledge to yield what is claimed -- i.e., whether there is some motivation or suggestion in the references, or in the knowledge held by one of ordinary skill in the art, to make the combination. If this were not part of the obviousness inquiry, the Examiner would be free to pick and choose elements of the claims willy-nilly from various prior art references, based only on hindsight guidance gleaned from Applicant's specification and claims. This is not the law.

Marshall is devoid of any motivation or suggestion to make the proposed combination. Furthermore, Hartori teaches away from making the proposed combination. Hartori discloses that the motivation for arranging data item icons in time order is to assist in searching for particular data items. For example, the background at columns 1 and 2 of Hartori disclose searching for a file when the user has only a "vague memory of date [sic] when a file is created or when the file is updated." There is nothing to suggest such that employing this Hartori data icon arrangement with the Marshall display would address a problem or disadvantage with the Marshall system/method or otherwise solve a problem with the Marshall arrangement of "stock metaphors."

If the Examiner continues to assert that it would be obvious to combine Marshall and Hartori, then Applicant respectfully requests that the Examiner cite where the references support this position. See 37 CFR 1.104(c)(2). Otherwise, Applicant requests that the Examiner submit

an affidavit of personal knowledge that one of ordinary skill in the art would suggest or motivate the combination of references. . .” 37 CFR 1.104(d)(2).

With specific regard to claims 20-34, these claims all recite allocating “linear” portions of the display corresponding to separate time segments and displaying, at each linear portion and along the linear portion, an indication of a value of a characteristic . . .” While the cited portion of Marshall discloses having three axes, none of these axes are disclosed having “portions” corresponding to separate time segments. Thus, Marshall fails to disclose this feature recited in claims 20-34. Hartori fails to cure this deficiency.

The combination of Marshall and Hartori also fails to disclose various features recited in the dependent claims. For example, with regard to claim 22 (see, e.g., Figure 7 of the present specification), Marshall and Hartori fail to disclose “displaying a rectangle having a length *along* the linear portion based on the value of the characteristic.”

As other examples, with regard to claims 35-46, the combination of Marshall and Hartori also fails to yield the subject matter recited in these claims. See, e.g., Figure 8 of the present specification. For example, with regard to claim 35, “each first shape indicates a number of associated venture capital firms having a value of a first particular characteristic within a range of values that correspond to that first shape.” The Examiner does not even address where it is considered that either Marshall or Hartori discloses such a feature. See, for example, page 3 of the Office Action, which purports to address claim 35 but which, in fact, does not. In any event, it is respectfully submitted that neither Marshall nor Hartori disclose this feature of claim 35. Various other features of claims 35-46 are also absent from the combination of Marshall and Hartori.

Finally, with respect to a number of the dependent claims in general, the Examiner’s alleged reasoning of the rejection merely recites feature of a dependent claim and then states, parenthetically, “see explanation on claim 1.” However, the “explanation on claim 1” does not address the claim feature of the dependent claim. Applicant wishes to remind the Examiner that, according to 37 CFR 1.104(c)(2), “the pertinence of each reference, if not apparent, must be

clearly explained and each rejected claim specified.” Applicant agrees that a reference to a previous explanation may, in principle, be sufficient to satisfy the requirement of 37 CFR 1.104(c)(2). However, in the present instance, where the previous explanation is devoid of any relevant material, then the reference to the previous explanation does not satisfy the 37 CFR 1.104(c)(2) requirement.

## CONCLUSION

Applicant has made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 426882005100.

Respectfully submitted,



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By:

Alan S. Hodes  
Registration No. 38,185

Morrison & Foerster LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
Telephone: (650) 813-5622  
Facsimile: (650) 494-0792